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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant(s) : David F. Gavin Docket No : 101792-100
Craig Waldron
Robert J. Martin
George A. Polson

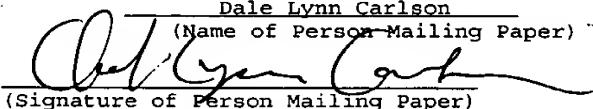
Serial No. : 09/120,664 Examiner : B. Celsa

Filed : July 22, 1998 Art Unit : 1627

For : COMPOSITE BIOCIDAL PARTICLES

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, Washington, DC 20231

Date: June 25, 01 Dale Lynn Carlson
(Name of Person Mailing Paper)

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BOARD OF PATENT APPEALS
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Commissioner for Patents
U.S. Patent and Trademark Office
Washington, DC 20231

REPLY BRIEF FOR DAVID F. GAVIN ET AL.

Dear Sir:

This Reply Brief is responsive to new issues and/or questions raised in the Examiner's Answer mailed on April 24, 2001 in the above-identified application.

First, the presumption recited at page 2, paragraph 2, of the outstanding Examiner's Answer to the effect that there are no "Related Appeals or Interferences" is correct; there are none. In this regard, it is pointed out at page 2 of appellants'

February 7, 2001 Appeal Brief that there are no related applications.

Second, it is stated at page 8 of the Examiner's Answer, in support of the alleged anticipation of the instant invention over Bernstein et al '971, that "ingredients within the scope of the presently claimed invention would inherently possess the same physical parameters, e.g. a shell and a core". This statement is believed to be misplaced. Bernstein et al discloses the production of zinc pyrithione as the chemical reaction product of pyrithione acid with another salt. This chemical reaction produces zinc pyrithione ("ZPT"), as described in the paragraph bridging pages 2 and 3 of the instant specification. However, this ZPT **chemical** reaction product does not disclose or suggest the **physical** combination (in a core/shell configuration) associated with the instantly claimed composite biocide particles of instant claim 1, much less the composite particles of claim 38 wherein the core comprises filler or biocide and the core comprises a pyrithione adduct derived from a portion of the core material.

Third, at page 11 of the Examiner's Answer, the instant anticipation rejection based upon a combination of Bernstein et al in combination with Oppong et al '960 is discussed. *In re Spada* is cited for the proposition that where the PTO has a sound basis for concluding that the appellants' products and the prior art products are the same, then the appellants have the burden to show that they are not. In point of fact, there

is no motivation in either reference to combine Bernstein et al with Oppong et al to produce any instantly claimed composite particle. Bernstein et al was discussed above. Oppong et al doesn't teach composite particles, but rather two different biocidal compounds (an ionene polymer and a pyrithione salt) said to provide a synergistic combination. It is axiomatic that the instant application cannot properly be used as a template to piece together the present invention absent some motivation in the prior art to do so. Absent hindsight reasoning with full knowledge of the present invention, the presently claimed composite particles are neither disclosed nor suggested by the cited prior art references, alone or in combination.

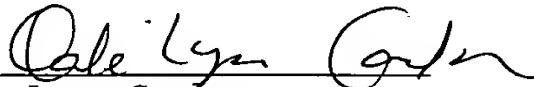
Reversal by the Board of the outstanding rejections of the instant claims is respectfully requested. No additional fee is believed to be required; however, if there is any fee, please charge deposit account #23-1665.

This brief is submitted in triplicate.

Respectfully submitted,

DAVID F. GAVIN ET AL.

6/25/01
Date


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